

## REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

### Summary of the Response

By the foregoing amendment, claims 1, 4, 5 and 8 have been amended and claims 2, 3, 6 and 7 have been canceled. No new matter has been added. Thus, claims 1, 4, 5 and 8 are pending in this application and subject to examination.

In the Office Action mailed September 22, 2005, claims 1 and 4-8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita (U.S. Patent No. 5,268,765, hereinafter "Yamashita"). Claims 2-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamashita in view of Aswell et al. (U.S. Patent No. 6,553,437, hereinafter "Aswell"). It is noted that claims 1, 4, 5 and 8 have been amended and claims 2, 3, 6 and 7 have been canceled. To the extent the rejections remain applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

### Claims 1, 4, 5 and 8 Recite Patentable Subject Matter

The Applicant respectfully submits that nothing in the cited prior art discloses or suggests at least the features of the present invention of one or more IC chips for reading an image, each IC chip comprising "a plurality of dummy photoelectric conversion elements, each of which is arranged in close proximity to and forms an exclusive pair with one of the plurality of image reading photoelectric conversion elements, and is shielded from light" and "a plurality of second transistors for reading a

second photoelectric conversion signal from the dummy photoelectric conversion elements," as recited in claims 1, 4, 5 and 8, as amended.

Each of the "plurality of dummy photoelectric conversion elements" claimed in amended claims 1, 4, 5 and 8 of the present invention is used to correct a variation of the output signal obtained from each of the photoelectric conversion elements, the variation being caused by a position and a light-shield condition of the photoelectric conversion element within the IC chip. (Emphasis added). Thus, for example, each of the claimed dummy photoelectric conversion elements of the present invention is "arranged in close proximity to and forms an exclusive pair with one of the plurality of image reading photoelectric conversion elements," for which a correction is performed.

By contrast, Yamashita only shows one dummy photocell 16 and one second transistor 17 per IC chip 15. One dummy photocell per IC chip suffices to accomplish the object of the Yamashita reference, which is to determine and fix a reference level for the dark output in the blanking portion of the output signal of the image sensor as soon as the outputs from the photocells in one IC chip are completed. There is nothing in Yamashita that discloses or suggests "a plurality of dummy photoelectric conversion elements" and "a plurality of second transistors" per a single IC chip, or correction of the output of each photocell by providing "a plurality of dummy photoelectric conversion elements, each of which is arranged in close proximity to and forms an exclusive pair with one of the plurality of image reading photoelectric conversion elements, and is shielded from light," as recited in claims 1, 4, 5 and 8 of the present invention, as amended.

For at least these reasons, the Applicant submits that claims 1, 4, 5 and 8 are allowable over the cited art.

Furthermore, with respect to each of the rejections under 35 U.S.C. §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness.

The PTO has the burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2nd 1596, 1598 (Fed. Cir. 1988). In making a rejection under 35 U.S.C. § 103, it is sometimes appropriate for an Examiner “to take official notice of facts not on the record or to rely on ‘common knowledge’ in making a rejection, however, such rejections should be judiciously applied.” See, e.g., MPEP § 2144.03. Official notice may not be taken without supporting documentation unless the facts so noticed serve only to “fill in the gaps” which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection. See *In re Zurko*, 258 F.3d 1379, 1385 (Fed. Cir. 2001). It is never appropriate to rely on “common knowledge” or officially noticed facts without evidentiary support in the record as the principal evidence upon which a rejection is based. *Id.* at 1386.

Furthermore, both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of

the references. *Id.* In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999); *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner admits that Yamashita fails to disclose or suggest an “output circuit for . . . outputting a difference between a first and second photoelectric conversion signals to correct the first photoelectric conversion signal.” See Office Action, at page 3. Further, the Examiner asserts Official Notice, without providing documentary evidence, that “one of ordinary skill in the art would have outputted the difference between the photocell signal and dummy photocell signal since this is the value of the light signal because the photocell signal is the sum of the dark current and the light signal.” *Id.* (Emphasis added). The Examiner then goes on to state that the motivation for combining Yamashita with the knowledge existing in the prior art (of which Official Notice is given), is exactly the same as the knowledge existing in the prior art, namely, “since this is the value of the light signal because the photocell signal is the sum of the dark current and the light signal.” *Id.* (Emphasis added).

The Applicant respectfully traverses the Examiner’s assertion of Official Notice, and submits that there is an insufficient showing of motivation, for the following reasons. First, there is nothing to suggest that one of ordinary skill in the art, at the time the invention was made, “would have outputted the difference between the photocell signal and dummy photocell signal,” as the Examiner asserts. Second, it is inappropriate to manufacture motivation to combine by reciting the exact same fact of which Official

Notice was taken as the “secondary” reference. Finally, Applicant respectfully submits that if the Examiner has chosen to rely on the same officially noticed fact, without supporting documentation, as a “secondary” reference and as motivation to combine, this fact must, by definition, be considered a “principal” ground for rejection, by far exceeding the “fill in the gaps” standard that the law permits for officially noticed facts without supporting documentation.

For at least these reasons, the Applicant submits that the Office Action has not presented a *prima facie* case of obviousness for the rejections under 35 U.S.C. § 103, and requests withdrawal of the rejections.

### **Conclusion**

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicant hereby petitions for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 103213-00042.

Respectfully submitted,



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